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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,962	06/29/2001	George B. Sigal	100405-6205	1824

7590

03/25/2003

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EXAMINER

SIEW, JEFFREY

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 03/25/2003

60

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/896,962

Applicant(s)

SIGAL ET AL.

Examiner

Jeffrey Siew

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 78-101 is/are pending in the application.
- 4a) Of the above claim(s) 98 and 101 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 78-97,99,100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### **Location of Application**

1. The location of the subject application has changed. The subject application is now located in Group 1630, Art Unit 1637, and is assigned to Patent Examiner Jeffrey Siew.

### ***Election/Restrictions***

2. Newly submitted claim 101 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 101 is drawn to the method of using the microparticle and is dependent on claim 98 which was drawn to Group 2 of the restriction in paper no. 4.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim\*\*\* withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

This application contains claim 78 & 101 drawn to an invention nonelected with traverse in Paper No. 4. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Oath/Declaration***

3. A new oath or declaration is required because the applicant has amended the claimed priority.. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 78-97, 99 & 100 are rejected under 35 U.S.C. 102(b) as being anticipated by Blackburn et al (Clin Chem. Vol. 37 no. 9 1991 pp. 1534-1539).

The teachings of Blackburn et al are described previously in Paper no. 7. Briefly, they teach a electrochemiluminescence microparticle with metal core Ru and electrochemiluminescent moieties to for the Ru microparticle.

Art Unit: 1637

5. Claims 78,85-88,94-97 & 100 are rejected under 35 U.S.C. 102(b) as being anticipated by Budibande et al (US5,597,910 January 28, 1997).

The teachings of Budibande et al are described previously in Paper no. 7. Briefly, they teach a electrochemiluminescence microparticle with metal center that will attach to oligonucleotides and disclose electrochemiluminescent moieties containing Ru, Re or OS.

6. Claims 78-82, 84-97 & 99 is rejected under 35 U.S.C. 102(b) as being anticipated by Oprandy (US 5,679,519 Oct 5, 1995).

The teachings of Oprandy et al are described previously in Paper no. 7. Briefly, they teach . Briefly, they teach a electorchmiluminscence microparticle with metal core and Ru associated electrochemiluminscent moieties.

7. Claims 83 &100 are rejected under 35 U.S.C. 102(b) as being anticipated by Mandle et al (US4,372,745).

The teachings of Mandle et al are described previously in Paper no. 7. Briefly, they teach a electrochmiluminscent particles enclosed within a liposome.

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 78-82,85-91,94—97, 99 & 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah et al (WO90/05301 May 17, 1990) .

The teachings and suggestion s of Shah et al are described previously. In paper no. 7.

One of ordinary skill in the art would have been motivated to make electrochemiluminescent particle that contain mixed metal centers or plastic centers motivated by Shah who teach that more binding partners may be attaché d to the moiety or have a plurality of binding species in one particle in order to bind to multiple targets.

9. The response states that Ru surrounded by bipyridyl groups does not support a 102 rejection. The term metal containing reads broadly and would read on the prior art of Blackburn et al, Gudibande et al and Oprande et al and Mandle et al and Shah et al each individually. The rejections are maintained.

**SUMMARY**

10. No claims allowed.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Siew whose telephone number is (703) 305-3886 and whose e-mail address is Jeffrey.Siew@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route. The examiner is on flex-time schedule and can best be reached on weekdays from 6:30 a.m. to 3 p.m.

Art Unit: 1637

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703)-308-1119.

Any inquiry of a general nature, matching or filed papers or relating to the status of this application or proceeding should be directed to the Tracey Johnson for Art Unit 1637 whose telephone number is (703)-305-2982.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Center numbers for Group 1600 are Voice (703) 308-3290 and Before Final FAX (703) 872-9306 or After Final FAX (703) 30872-9307.

  
**JEFFREY SIEW**  
**PRIMARY EXAMINER**

March 23, 2003